

REMARKS / ARGUMENTS

The present application includes pending claims 1-32, all of which have been rejected. By this Amendment, claims 1 and 11-22 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 1-32 stand rejected under 35 U.S.C. § 101 because the claims are allegedly directed to a non-statutory subject matter. Claims 1-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0093485, issued to Dougall (hereinafter, Dougall), in view of U.S. Patent Publication No. 2002/0166123, issued to Schrader, et al. (hereinafter, Schrader). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 101

The Applicant turns to the rejection of claims 1-32 under 35 U.S.C. § 101. The Office Action states the following in page 2:

Claims 1-32 are rejected under 35 U.S.C. 101 because the claims are directed to a nonstatutory subject matter, specifically, the claims are not directed towards the final result that is "useful, tangible and concrete."

THE APPLICANT RESPECTFULLY SUBMITS THAT THE REJECTION UNDER 35 USC §101 IS IMPROPER SINCE THE APPLICANT'S CLAIMED INVENTION PRODUCES A USEFUL, TANBGIBLE AND CONCRETE RESULT, AND HAS PRACTICAL APPLICATION.

The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

I. The Scope of 35 USC §101

Title 35 USC § 101 states:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The Supreme Court held, Congress chose the expansive language of 35 U.S.C. § 101 so as to include "anything under the sun that is made by man." Diamond v. Chakrabarty, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980). In Chakrabarty, 447 U.S. at 308-309, 206 USPQ at 197, the court stated:

In choosing such expansive terms as "manufacture" and "composition of matter," modified by the comprehensive "any," Congress plainly contemplated that the patent laws would be given wide scope. The relevant legislative history also supports a broad construction. The Patent Act of 1793, authored by Thomas Jefferson, defined statutory subject matter as "any new and useful art, machine, manufacture, or composition of matter, or any new or useful improvement [thereof]." Act of Feb. 21, 1793, ch. 11, § 1, 1 Stat. 318. The Act embodied Jefferson's philosophy that "ingenuity should receive a liberal encouragement." V Writings of Thomas Jefferson, at 75-76. See *Graham v. John Deere Co.*, 383 U.S. 1, 7-10 (148 USPQ 459, 462-464) (1966). Subsequent patent statutes in 1836, 1870, and 1874 employed this same broad language. In 1952, when the patent laws were recodified, Congress replaced the word "art" with "process," but otherwise left Jefferson's language intact. The Committee Reports accompanying the 1952 Act inform us that Congress intended statutory subject matter to "include anything under the sun that is made by man." S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952). [Footnote omitted]

This perspective has been embraced by the Federal Circuit:

The plain and unambiguous meaning of section 101 is that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in Title 35, such as those found in sections 102, 103, and 112. The use of the expansive term "any" in section 101 represents Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101 and the other parts of Title 35.... Thus, it is improper to read into section 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations. See *Alappat*, 33 F.3d at 1542, 31 USPQ2d at 1556.

II. Four Judicial Exceptions

Title 35 U.S.C. § 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter. The latter three categories define "things" or "products" while the first category defines "actions" (i.e., inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) ("The term 'process' means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.").

Federal courts have held that 35 U.S.C. § 101 does have certain limits. First, the phrase "anything under the sun that is made by man" is limited by the text of 35 U.S.C. § 101, meaning that one may only patent something that is a machine, manufacture, composition of matter or a process. See, e.g., *Alappat*, 33 F.3d at 1542, 31 USPQ2d at 1556; *In re Warmerdam*, 33 F.3d 1354, 1358, 31 USPQ2d 1754, 1757 (Fed. Cir. 1994). Second, 35 U.S.C. § 101 requires that the subject matter sought to be patented be a "useful" invention. Accordingly, a complete definition of the scope of 35 U.S.C. § 101, reflecting Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent.

The subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena. While this is easily stated, determining whether an applicant is seeking to patent an abstract idea, a law of nature or a natural phenomenon has proven to be challenging. These three exclusions recognize that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon is not patentable. See, e.g., *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874) ("idea of itself is not patentable, but a new device by which it may be made practically useful is"); *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939) ("While a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be."); *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759 ("steps of 'locating' a medial axis, and 'creating' a bubble hierarchy . . . describe nothing more than the manipulation of basic mathematical constructs, the paradigmatic 'abstract idea'").

The courts have also held that a claim may not preempt ideas, laws of nature or natural phenomena. The concern over preemption was expressed as early as 1852. See *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1852) ("A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.");

Funk Bros. Seed Co. v. Kalo Inoculant Co., 333 U.S. 127, 132, 76 USPQ 280, 282 (1948) (combination of six species of bacteria held to be nonstatutory subject matter). Accordingly, one may not patent every "substantial practical application" of an idea, law of nature or natural phenomena because such a patent "in practical effect be a patent on the [idea, law of nature or natural phenomena] itself." See Gottschalk v. Benson, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972).

The scope of 35 U.S.C. § 101 is the same regardless of the form or category of invention in which a particular claim is drafted. See AT&T, 172 F.3d at 1357, 50 USPQ2d at 1451. See also State Street, 149 F.3d at 1375, 47 USPQ2d at 1602 wherein the Federal Circuit explained:

The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter--[provided the subject matter falls into at least one category of statutory subject matter] but rather on the essential characteristics of the subject matter, in particular, its practical utility.

For example, a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine. Such instances of mixed attributes, although potentially confusing as to which category of patentable subject matter it belongs in, does not affect the analysis to be performed by the Examiner. Note that an apparatus claim with process steps is not classified as a "hybrid" claim; instead, it is simply an

apparatus claim including functional limitations. See, e.g., *R.A.C.C. Indus. v. Stun-Tech, Inc.*, 178 F.3d 1309 (Fed. Cir. 1998).

The burden is on the USPTO to set forth a prima facie case of unpatentability. Therefore, if the Examiner determines that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, the Examiner must provide an explanation. For example, a claim reciting only a musical composition, literary work, compilation of data, or legal document (e.g., an insurance policy) per se does not appear to be a process, machine, manufacture, or composition of matter. If the Examiner can establish a prima facie case that a claim does not fall into a statutory category, that does not preclude complete examination of the application for satisfaction of all other conditions of patentability. The Examiner must further continue with the statutory subject matter analysis as set forth below. Also, the Examiner must still examine the claims for compliance with 35 U.S.C. §§ 102, 103, and 112.

Determining whether the claim falls within one of the four enumerated categories of patentable subject matter recited in 35 U.S.C. § 101 (process, machine, manufacture or composition of matter) does not end the analysis because claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible and therefore are excluded from patent protection. See *Diehr*, 450 U.S. at 185, 209 USPQ at 7; accord, e.g., *Chakrabarty*, 447 U.S. at 309, 206 USPQ at 197;

Parker v. Flook, 437 U.S. 584, 589, 198 USPQ 193, 197 (1978); Benson, 409 U.S. at 67-68, 175 USPQ at 675; Funk, 333 U.S. at 130, 76 USPQ at 281. "A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right." See Le Roy, 55 U.S. (14 How.) at 175. Instead, such "manifestations of laws of nature" are "part of the storehouse of knowledge," "free to all men and reserved exclusively to none." See Funk, 333 U.S. at 130, 76 USPQ at 281.

While abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be. In evaluating whether a claim meets the requirements of section 101, the claim must be considered as a whole to determine whether it is for a particular application of an abstract idea, natural phenomenon, or law of nature, rather than for the abstract idea, natural phenomenon, or law of nature itself.

III. Determine Whether the Claimed Invention Covers Either a § 101 Judicial Exception or a Practical Application of a § 101 Judicial Exception

An Examiner must ascertain the scope of the claim to determine whether it covers either a § 101 judicial exception or a practical application of a § 101 judicial exception. The conclusion that a particular claim includes a § 101 judicial exception does not end the inquiry because "[i]t is now commonplace that an

application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection." See *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (emphasis in original); accord *Flook*, 437 U.S. at 590, 198 USPQ at 197; *Benson*, 409 U.S. at 67, 175 USPQ at 675. Thus, "[w]hile a scientific truth, or the mathematical expression of it, is not a patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be." *Diehr*, 450 U.S. at 188, 209 USPQ at 8-9 (quoting *Mackay*, 306 U.S. at 94); see also *Corning v. Burden*, 56 U.S. (15 How.) 252, 268, 14 L.Ed. 683 (1854)("It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . .").

IV. Determine Whether the Claimed Invention is a Practical Application of an Abstract Idea, Law of Nature, or Natural Phenomenon (§ 101 Judicial Exceptions)

For claims including such excluded subject matter to be eligible, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. See Diehr, 450 U.S. at 187, 209 USPQ at 8 (“application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”); Benson, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it “has no substantial practical application”).

To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways: the claimed invention “transforms” an article or physical object to a different state or thing; and the claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

A. Practical Application by Physical Transformation

The Examiner first shall review the claim and determine if it provides a transformation or reduction of an article to a different state or thing. If the Examiner finds such a transformation or reduction, the Examiner shall end the inquiry and find that the claim meets the statutory requirement of 35 U.S.C. § 101. If the Examiner does not find such a transformation or reduction, the Examiner has

not determined as a final matter that the claim is non-statutory. The Examiner must proceed in further inquiry.

B. Practical Application That Produces a Useful, Concrete, and Tangible Result

For eligibility analysis, physical transformation "is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application." See AT&T, 172 F.3d at 1358-59, 50 USPQ2d at 1452. If the Examiner determines that the claim does not entail the transformation of an article, then the Examiner shall review the claim to determine if the claim provides a practical application that produces a useful, tangible and concrete result. **In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete."** The claim must be examined to see if it includes anything more than a § 101 judicial exception. If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. § 101. If the Examiner does not find such a practical application, the Examiner has determined that the claim is nonstatutory.

In determining whether a claim provides a practical application that produces a useful, tangible, and concrete result, the Examiner should consider and weigh the following factors:

1. Useful Result

For an invention to be "useful" it must satisfy the utility requirement of section 101. The USPTO's official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107 and Fisher, 421 F.3d, 76 USPQ2d at 1230 (citing the Utility Guidelines with approval for interpretation of "specific" and "substantial").

2. Tangible Result

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. See Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application."). "[A]n application of a law of nature or mathematical formula to a ...

process may well be deserving of patent protection." See Diehr, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also Corning, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 ("It is for the discovery or invention of some practical method or means of producing a beneficial result or effect that a patent is granted . . ."). In other words, the opposite meaning of "tangible" is "abstract."

3. Concrete Result

Another consideration is whether the invention produces a "concrete" result. **Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again.** See *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of

enablement rejection under 35 U.S.C. § 112, paragraph 1, where the invention cannot operate as intended without undue experimentation. See *infra*.

C. Establishing a Prima Facie Case

The Examiner should review the totality of the evidence (e.g., the specification, claims, relevant prior art) before reaching a conclusion with regard to whether the claimed invention sets forth patent eligible subject matter. The Examiner must weigh the determinations made above to reach a conclusion as to whether it is more likely than not that the claimed invention as a whole either falls outside of one of the enumerated statutory classes or within one of the exceptions to statutory subject matter. **“The Examiner bears the initial burden ... of presenting a prima facie case of unpatentability.”** See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **If the record as a whole suggests that it is more likely than not that the claimed invention would be considered a practical application of an abstract idea, natural phenomenon, or law of nature, the Examiner should not reject the claim.**

After the Examiner identifies and explains in the record the basis for why a claim is for an abstract idea with no practical application, then the burden shifts to the Applicant to either amend the claim or make a showing of why the claim is eligible for patent protection. See, e.g., *In re Brana*, 51

F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995); see generally MPEP § 2107 (Utility Guidelines).

V. Regarding the Applicant's Claims 1-32, the Examiner Has Failed to Establish a Prima Facie Case of Unpatentability

The Applicant respectfully asserts that the Examiner has not established a prima facie case of unpatentability since the Examiner has not identified and explained **"the basis for why a claim is for an abstract idea with no practical application."** Accordingly, the burden has not shifted to the Applicant to either amend the claim or make a showing of why the claim is eligible for patent protection. See, *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995). See also, generally, MPEP § 2107.

A. The Applicant's Invention Produces Useful, Tangible And Concrete Results

The Examiner states the following in page 3 of the Office Action:

Applicant's independent claims 1, 11 and 21 recite conditional limitations for producing results, such as the claimed, "if said storage unit is transferred to a second location..." (Claim 5, for example), "such that if the condition is not met, the claims will generate no useful, concrete, and tangible results. The result of the claimed, "transferring" is conditional and will take place only the claimed, "if said storage unit is transferred to a second location..." There appears to be no creation or transformation or production of any useful, concrete, and tangible results.

The Applicant respectfully asserts that the disclosed and claimed invention produces useful, tangible and concrete results. The Applicant's invention provides utility that is (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107 and Fisher, 421 F.3d, 76 USPQ2d at 1230. **For example, each of claims 1-32 provides a practical application that produces a useful result, i.e., a method (or system) for porting information between locations in a communication network. In addition, for purposes of expediting prosecution of the present application, the Applicant has amended independent claims 1, 11, and 21 to remove the conditional language using "if said storage unit is transferred."**

Furthermore with regard to the 35 USC § 101 rejection, the Applicant's disclosed and claimed invention clearly does not fall in the category of the § 101 Judicial exceptions. Accordingly, there is no need for the Applicant to distinguish the disclosed and/or claimed subject matter from the three § 101 judicial exceptions to patentable subject matter by specifically reciting in the claim the practical application.

The Examiner also states the following in page 4 of the Office Action:

Regarding independent Claims 1, 11 and 21, contends that the claimed, "storing.... transferred... presenting... receiving... displaying... does not produce a tangible result. (see claim 1 for example). Examiner recommends that to satisfy the 101 rejection, that the claims must produce a real-world result.

The Examiner is respectfully reminded that the "tangible" requirement does not necessarily mean that a claim must either be tied to a particular machine or

apparatus or must operate to change articles or materials to a different state or thing. **With regard to tangible results, the Applicant respectfully asserts that the disclosed and claimed invention recites more than a § 101 judicial exception and that the claims specifically set forth a practical application to produce a real-world result, such as a method (or system) for porting information between locations in a communication network.**

With regard to concrete results, since appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, in instances where the invention cannot operate as intended without undue experimentation. Since no such rejection was received, the Applicant assumes that the invention provides useful results. Notwithstanding, the Applicant respectfully asserts that the disclosed and claimed invention provides useful results and the results are repeatable and predictable.

The Applicant points out that the preambles of independent claims 1, 11, and 21 specifically recite the utility of Applicant's claims, i.e., for porting information between locations in a communication network. At least for the above reasons, the Applicant believes that Claims 1-32 comprise patentable subject matter and are believed to be allowable.

Accordingly, the Applicant courteously requests that the rejection under 35 USC § 101 be withdrawn and each of Claims 1-32 be allowed. The Applicant

reserves the right to argue additional reasons beyond those set forth above that support the allowability of all rejected claims.

B. Rejection of Claims 11-20 under 35 USC § 101

Claims 11-20 were rejected under 35 U.S.C.101 because the claimed invention is allegedly directed to non-statutory subject matter. The Examiner states the following in page 3 of the Office Action:

Regarding Claims 11-20, Examiner contends that computer programs do not define any structural and functional relationships between the computer program and other claimed elements of a computer which permit the computer's program functionality to be realized. Yet, a computer readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and thus is statutory.

The Applicant respectfully disagrees. The Examiner is referred to the following citation from the MPEP:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, **"functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component.** (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) **"Nonfunctional**

descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

See Manual of Patent Examining Procedure (MPEP), Chapter 2100.6. The Applicant points out that the descriptive material in the preamble of claim 11 is not related to “music, literary works, and a compilation or mere arrangement of data.” Instead, the Applicant submits that the descriptive material in the preamble of claim 11 is related to “computer programs which impart functionality when employed as a computer component.” In other words, the material in the preamble of claim 11 is “functional descriptive material.” The Examiner is also referred to the following MPEP citation for support:

When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

See id. The Applicant points out that claims 11-20 have been amended to recite a “computer-readable medium”, which is the phraseology used in the above MPEP analysis. The Applicant, therefore, submits that the material in the preamble of claim 11 is functional descriptive material, which is also statutory, as per the above MPEP guidelines. The Applicant submits that claims 11-20 are directed to statutory subject matter, and that the rejection of claims 11-20 under 35 USC § 101 should be withdrawn.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Dougall and Schrader Does Not Render Claims 1-32 Unpatentable

The Applicant turns to the rejection of claims 1-32 as being unpatentable over Dougall in view of Schrader. The Applicant notes that the proposed combination of Dougall and Schrader forms the basis for all of the pending rejections.

A. The Proposed Combination Does Not Teach or Suggest “Transferring a Storage Unit From a First Location to a Second Location” (First Claim Limitation)

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Dougall and Schrader does not disclose or suggest at least the limitation of “storing media and metadata ... on a storage unit ... at a first location, and presenting a channel guide in a second location ... when said storage unit is transferred to said second location and coupled to a second communication device at said second location,” as claimed by the Applicant in independent claim 1. More specifically, *Dougall does not teach storing media and meta data associated with the media on a **storage unit** coupled to a communication device at a first location, and transferring the storage unit*

to a second location and coupling it to a second communication device at the second location. In the Office Action, the Examiner states the following:

Regarding Claim 1, 11, and 21, Dougall teaches porting information between locations in a communication network[0034], the method comprising: storing media along with meta data associated with said stored media on a storage unit coupled to a communication device at a first location; if said storage unit is transferred to a second location and coupled to a second communication device at said second location, presenting a channel guide comprising representations of said stored media on a television [0061][0069] in said second location [0129][0023]; and in response to receiving a selection via said presented channel guide[0129], displaying at least one media file corresponding to said received selection on at least one of said television and a media player in said second location[0023].

See the Office Action at page 5. The Applicant respectfully disagrees with the Examiner's argument. The Applicant points out that the Examiner has cited paragraphs 0061, 0069, 0129, and 0023 of Dougall in support of the First Claim Limitation. Paragraph 0061 of Dougall discloses a general network architecture of Figure 1, and paragraph 0069 discloses a router node 230 and client nodes 240. Paragraph 0129 of Dougall discloses providing of service announcements by the session manager 820, and paragraph 0023 discloses delivery of best-efforts data and real-time data. It is unclear what the Examiner is referring to by citing paragraphs 0061, 0069, 0129, and 0023 of Dougall since *none of these paragraphs disclose or suggest the limitation of "storing media and metadata ... on a storage unit ... at a first location and if said storage unit is transferred to a*

second location and coupled to a second communication device at said second location ... presenting ... a channel guide," as claimed by the Applicant in independent claim 1. In fact, **neither Dougall nor Schrader disclose or suggest a storage unit or any other device that is coupled to a first communication device at a first location and, when transferred, the same storage unit is now coupled to a second communication device at a second location.**

Additionally, the Examiner concedes in the Office Action (page 5) that Dougall does not teach the limitation of "based on said meta data associated with said storage media on said transferred storage unit," as called for in independent claim 1. The Applicant respectfully agrees.

Accordingly, the proposed combination of Dougall and Schrader does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is, therefore, allowable at least for the above reasons.

B. The Proposed Combination Does Not Teach or Suggest "Displaying Based On Said Meta Data ... On Said Transferred Storage Unit, At Least One Media File ... On Said Television ... In Said Second Location" (Second Claim Limitation)

With regard to the rejection of independent claim 11 under 103(a), the Applicant submits that the combination of Dougall and Schrader does not disclose or suggest at least the limitation of "displaying based on said meta data ... on said

transferred storage unit, at least one media file ... on said television ... in said second location," as recited by the Applicant in independent claim 1.

The Examiner refers for support to paragraph 0023 of Dougall. Paragraph 0023 of Dougall discloses delivery of best-efforts data and real-time data. Neither Dougall nor Schrader discloses storing of media and meta data on a storage unit at a first location, and, if the storage unit is transferred to a second location, displaying a media file on a TV in the second location **based on the meta data on the transferred storage unit**.

Accordingly, the proposed combination of Dougall and Schrader does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is, therefore, allowable at least for the above reasons. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the proposed combination of Dougall and Schrader at least for the reasons stated above with regard to claim 1.

C. Rejection of Dependent Claims 2-10, 12-20 and 22-32

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being unpatentable

over Dougall in view of Schrader has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-10, 12-20 and 22-32 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-32.

CONCLUSION

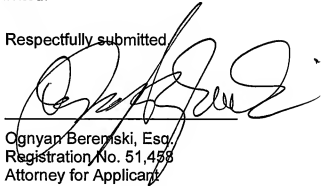
Based on at least the foregoing, the Applicant believes that all claims 1-32 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Date: 12-JUL-2007

Respectfully submitted



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